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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIYAN S. HUA and AHMED N. ZAKI

Appeal 2009-004545
Application 10/087,291
Technology Center 2100

Decided: June 24, 2010

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-20. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). We affirm.

Invention

Appellants have invented a method of searching TV programming information that includes receiving a telephone call from a viewer via a telephone system, generating a search query in response to the telephone call, and searching a database in accordance with the search query. The database contains TV programming information. Search results generated from the searching include entries from the database that correspond to the search query. The search results are then sent to a TV receiver box of the viewer via a TV system such that they are displayable upon a TV operatively connected to the receiver box. (Spec. 2).

Claim 11 is illustrative:

11. A service control point connected to a telephone system and a television system, said service control point comprising:
 - query generating means for generating a search query in response to a telephone call received from a viewer via the telephone system;
 - a database in which television programming information is maintained; and,
 - searching means for searching the database in accordance with the search query received from the query generating means, said searching means generating search results which are sent to a television receiver box of the viewer via the television system such that said search results are displayable upon a television operatively connected to the television receiver box.

Appellants appeal the following rejection:

1. Claims 1-20 as unpatentable under 35 U.S.C. § 103(a) over the combination of Junqua (U.S. Patent 6,314,398 B1, Nov. 6, 2001), and Korall (U.S. Patent 6,996,531 B2, Feb. 7, 2006).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Did the Examiner err by improperly combining the Junqua and Korall references under § 103?
2. Under § 103, did the Examiner err by finding that the combination of Junqua and Korall would have taught or suggested a “service control point” within the meaning of representative claim 11?
3. Under § 103, did the Examiner err by finding that the combination of Junqua and Korall would have taught or suggested a caller ID within the meaning of dependent claims 2 and 19?

FINDINGS OF FACT

1. Korall teaches receiving voice data from telephony devices (col. 3, ll. 56-60) where the voice data is further processed by a speech recognition unit 22 to generate a database search query in response to the telephone call. (Col. 4, ll. 51-54, 59-64).
2. Korall teaches an application that performs reverse searching to identify the senders of incoming calls or messages. Instead of displaying a telephone number on the screen, Korall teaches it is possible to display a sender name. (Col. 9, l. 67 through col. 10, l. 3).
3. Junqua teaches selecting the desired TV program based upon spoken natural language requests. (Col. 2, ll. 8-10).

GROUPING OF CLAIMS

Appellants argue claims 1 and 11 as a group (regarding the combinability of the references), claim 11 separately (regarding a specific limitation) and claims 2 and 19 as a group. Based upon Appellants' arguments (*See* App. Br. 11-12), we select claim 11 as representative for remaining claims 1, 3-10, 12-18, and 20 that are not argued separately. We select claim 2 as representative of the group consisting of claims 2 and 19. (App. Br. 12). *See* 37 C.F.R. § 41.37(c)(vii).

ANALYSIS

Issue 1

We decide the question of whether the Examiner erred by improperly combining the Junqua and Korall references under § 103.

Appellants contend that the Examiner has failed to show a motivation to combine the teachings of Junqua and Korall. (App. Br. 10-11). Appellants further contend that Korall is non-analogous art. (App. Br. 11).

At the outset, we observe that the Examiner merely looks to the secondary Korall reference as evidence that generating a search query in response to a telephone call was known to artisans at the time of Appellants' invention. (Ans. 5; *see also* FF 1).

Based on this record, we are of the view that Appellants' purported improvement over the prior art represents no more than the predictable use of prior art elements (i.e., a telephone call, a database search query generated from the telephone call, and a TV programming system) according to their established functions, and thus would have been obvious to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.”) (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

We note that a reference is analogous art if “even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992); *see also KSR*, 550 U.S. at 420 (“[F]amiliar items may have obvious uses beyond their primary purposes.”).

Here, we find the relied upon features of the secondary Korall reference (FF 1 - generating a database search query in response to a telephone call) would have logically commended itself to an inventor's attention in considering the problem addressed by Junqua, i.e., using natural language to select the desired TV program based upon spoken requests. (FF 3).

Moreover, given the breadth of Appellants' representative claim 1, we are not persuaded that combining the respective familiar elements of the cited references in the manner proffered by the Examiner would have been “uniquely challenging or difficult for one of ordinary skill in the art” at the time of Appellants' invention (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner's proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.¹

¹ *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (explaining that whether there is “a reasonable expectation of success in making the invention via” a combination of prior art elements is a question of fact).

Lastly, we note that Appellants have not rebutted the Examiner's legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

Thus, when we take account of the inferences and creative steps that a person of ordinary skill in the art would have employed, we find the Examiner has articulated an adequate reasoning with a rational underpinning that reasonably supports the legal conclusion of obviousness.

Therefore, we find Appellants' arguments unavailing regarding the combinability of the cited references for essentially the same reasons proffered by the Examiner in the Answer, and for the additional reasons discussed above. Accordingly, we find the Examiner did not err by improperly combining the Junqua and Korall references under § 103.

Issue 2

We decide the question of whether the Examiner erred by finding that the combination of Junqua and Korall would have taught or suggested a service control point within the meaning of representative claim 11.

Appellants state that "claim 11 is directed to a service control point connected to a telephone system and a television system. Neither Junqua nor Korall disclose search a service control point." (App. Br. 12).

We note that the "service control point" recited in the preamble of claim 11 is comprised of at least the three elements recited in the claim body: (1) a query generating means, (2) a database, and (3) searching means.

The Examiner has set forth detailed findings for each of these elements on pages 4-5 of the Answer. We find Appellants have failed to present substantive arguments traversing the Examiner's factual findings regarding the three elements of the claimed "service control point." (Claim 11).

Mere attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); 37 C.F.R. § 1.111(b); and *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>

This reasoning is applicable here. We note that we have fully addressed the combinability issue *supra*. Accordingly, we sustain the Examiner's § 103 rejection of independent claim 11. Claims 1, 3-10, 12-18, and 20, not argued separately, fall with representative claim 11. *See* 37 C.F.R. § 41.37(c)(vii).

Issue 3

We decide the question of whether the Examiner erred by finding that the combination of Junqua and Korall would have taught or suggested a caller ID within the meaning of dependent claims 2 and 19.

Appellants contend that the passage cited by the Examiner is not referring to a caller ID, or even identifying the user. (App. Br. 12). Appellants further aver that Korall's reverse directory look-up (where a user enters a telephone number and the output is the name of the subscriber associated with that telephone number) is not the same as caller ID, and it

does not identify the individual calling directory assistance to perform the search. (*Id.*).

We do not find Appellants' arguments persuasive given that Korall teaches an application that performs reverse searching to identify the senders of incoming calls or messages by name. Instead of displaying a telephone number on the screen, Korall teaches displaying the sender's name. (FF 3). This is the essence of the caller-ID function. Therefore, we find Korall is at least extremely suggestive of the argued caller-ID limitations, even though Korall does not expressly disclose a literal caller-ID per se. (Claims 2 and 19). Moreover, we note that the Examiner's obviousness rejection is based on the combination of the teachings of Junqua and Korall.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR*, 550 U.S. at 405. We find this reasoning applicable here.

Therefore, for essentially the same reasons set forth by the Examiner in the Answer (pp. 5-6 and 11), and as discussed above, it is our view that the Examiner did not err in reaching the legal conclusion that the combination of Junqua and Korall would have rendered the limitations of claims 2 and 19 obvious to an artisan at the time of the invention.

CONCLUSION

For at least the aforementioned reasons (discussion of Issues 1, 2, and 3), we sustain the Examiner's obviousness rejection of claims 1-20.

DECISION

We affirm the Examiner's § 103 rejection of claims 1-20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

AFFIRMED

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